

REMARKS

At the time of the Office Action dated April 14, 2003, claims 1-30 were pending in this application. Claims 1-30 have been rejected. The specification at page 6, line 1 has been amended to correct a typographical error. Claims 4, 7, 12, 15, 23 and 28 have been amended and claim 30 has been canceled. Adequate support for the amendment is found at page 14, lines 9-29; and page 15, Example. Accordingly, entry and consideration of the amendment are respectfully requested.

Claims 4, 5, 7, 12, 13, 15, 20, 21, 23, 28 and 29 were rejected under 35 U.S.C. § 112, second paragraph. Claims 5, 13, 21, and 29 were rejected for depending from a claim rejected under 35 U.S.C. § 112. Applicants respectfully traverse.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law. *Tillotson Ltd. v Walbor Corp.*, 4 USPQ 2d 1450 (Fed. Cir. 1987). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the PTO is required to discharge its initial burden for providing a basis in fact and/or cogent reasoning to support the ultimate legal conclusion that one having ordinary skill in art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by the claim. *In re Cartwright*, 49 USPQ 2d 1464. Consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Miles Laboratories, Inc. v. Shandon, Inc.*, 27 USPQ 2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. Amercian Cyanamide Co.*, 28 USPQ 2d 1333 (Fed. Cir. 1993); *U.S. v. Telectronics, Inc.*, 8 USPQ 2d 1217 (Fed. Cir. 1988). Applicant stresses that a patent specification

must be viewed through the eyes of one having ordinary skill in the art. *Miles Laboratories, Inc. v. Shandon, Inc., supra.*

Claims 4, 7, 12, 15, 20, 23 and 28 have been amended to recite, in pertinent part, that the reactive groups of the piperidine derivative may comprise a carboxylic ester. Applicants submit that one having ordinary skill in the art would not have difficulty understanding the scope of the presently claimed invention, particularly when reasonably interpreted in light of the supporting specification. See specification at page 14, lines 9-29; and page 15, Example. Therefore, it is respectfully submitted that the imposed rejection of claims 4, 5, 7, 12, 13, 15, 20, 21, 23, 28 and 29 under 35 U.S.C. § 112, second paragraph is not legally viable and hence, solicit withdrawal thereof.

Claims 1-30 were rejected under 35 U.S.C. § 102(b) as being anticipated over Yamana et al. (U.S. Pat. No. 5,965,496, hereinafter "Yamana"). The Examiner stated that the claims were anticipated over Yamana in view of the lubricant of example 1 as applied to a carbon coated hard disc in example 7 and formula 1'. Applicants respectfully traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). In imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist*

& *Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the method and device disclosed by Yamana that would preclude the factual determination that Yamana identically describe the claimed inventions within the meaning of 35 U.S.C. § 102.

Specifically, each of independent claims 1, 9, 17 and 26 recites, in pertinent part, a perfluoropolyether chain and at least one Hindered Amine Light Stabilizer (HALS) moiety at at least one end of the perfluoropolyether chain. Applicants respectfully submit that Yamana does not disclose a HALS moiety at one or both ends of the perfluoropolyether chain. Yamana discloses that Z1, Z2 and Z3 are a group containing an organic free radical. See col. 2, lines 19-20 and col. 3, line 4 through col. 4, line 15. Yamana, at col. 22, Example 1, discloses the reaction between a nitroxide (Tempol -- 4-hydroxy-2,2,6,6-tetramethyl-4-piperidine-1-oxyl) and a fluorine containing polyether. Tempol contains an organic free radical ( $=N-O^*$ ) and cannot be considered a HALS compound, which by definition contains a hindered amine. Thus, Yamana does not disclose every limitation of independent claims 1, 9, 17 and 26 and, therefore, the rejection is not viable.

Moreover, Yamana discloses that the organic free radicals tethered on the lubricants are for the purpose of enhancing lubricant bonding on an overcoat. However, according to the present invention, the stability of perfluoropolyether-based lubricants utilized in the manufacture and use of thin film magnetic and/or MO recording media in disk form, particularly against acid-catalyzed catalytic composition (as in the presence of a Lewis acid, such as  $Al_2O_3$ ), is significantly improved by synthetic attachment of at least

one Hindered Amine Light Stabilizer ("HALS") moiety to at least one end of a generally linear chain perfluoropolyether compound. See pages 13-14 of the specification and FIGS 1 and 2.

It is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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